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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,384	08/03/2001	Dai Sasaki	9792909-5175	8116

26263 7590 11/20/2002  
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EXAMINER
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PATEL, ISHWARBHAI B

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/922,384	SASAKI ET AL.
<b>Examiner</b>	<b>Art Unit</b>	
Ishwar (I. B.) Patel	2827	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on 03 August 2001 .

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-6 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-6 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 03 August 2001 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ . 6)  Other: \_\_\_\_\_ .

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to because the figures are improperly cross hatched. The cross hatching patterns should be selected from those shown on page 600-81 of the MPEP based on the material of the part. See also 37 CFR 1.84(h)(3) and MPEP 608.02.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in–  
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Murakami, US Patent No. 5,874,780.

Regarding claims 1, 2 and 3, Murakami discloses a mounting structure of a semiconductor device mounted on a mounting substrate, comprising:

a semiconductor device having a bump electrode, which has an acute tip on top (semiconductor device 105 with bump electrode 107, see figures 2A-C, column 3, line 15 to column 4, line 8),

a mounting substrate on which said device is mounted (substrate 101, see figure 2A-C, column 3, line 15 to column 4, line 8), and

a conductor pattern formed on said mounting substrate, wherein said acute tip is gradually depressed on said conductor pattern of said mounting substrate (mounting pad 103, figure 2A-C, column 3, line 15 to column 4, line 8).

Regarding claims 2 and 3, the leveling process in claim 2 and the application of heat in claim 3, are the process limitations in the product claim. Such process limitation defines the claimed invention over the prior art only to the degree that it defines the product itself. A process limitation cannot serve to patentably distinguish the product over the prior art, in case that the product is the same as, or obvious over, the prior art. See product-by-process in MPEP 2113 and 2173.05(p) and *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

Regarding claim 4, Murakami further discloses the mounting substrate is printed circuit board (circuit substrate 101, see figures 2A-C, column 3, line 15-20).

Regarding claim 5, Murakami further disclose an electrode pad on which the said electrode bump is formed (semiconductor device 105 with bump electrode 107 on electrode pad 108, see figures 2A-C, column 3, line 15 to column 4, line 8).

Regarding claim 6, Murakami further discloses the acute tip of the bump has shape of a cone (see figure 2A).

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kira et al., Takase et al., Mori et al., Bessho, Tsunoi, and Ohuchi et al., disclose structure similar to applicant's claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ishwar (I. B.) Patel whose telephone number is (703) 305 2617. The examiner can normally be reached on M-F (6:30 - 4) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L Talbott can be reached on (703) 305 9883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305 3431 for regular communications and (703) 305 7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 0956.

ibp  
November 16, 2002

*Albert W. Paladin* 11-16-02  
ALBERT W. PALADIN!  
PRIMARY EXAMINER